

## **REMARKS**

### **I. SUPPORT FOR THE CLAIM AMENDMENTS**

Claims 1 and 32 have been amended to better capture the envisioned commercial embodiments. Support for the claim amendments can be found throughout the specification and originally filed claims. Specifically, support for the amendments to claims 1 and 32 can be found in at least paragraphs 0051 and 0074-0078 of Pre-Grant Publication No. 2004/0179197. Accordingly, no new matter has been introduced by way of these amendments.

### **II. THE ANTICIPATION REJECTION IS MOOT**

The Office Action of July 5, 2006 rejected claims 1-5, 7, 8, 18, 19 and 32-35 under 35 U.S.C. 102(e) as allegedly being anticipated by Schultz (US 6,180,415). Specifically, the Office Action stated that “Schultz discloses determination of a dynamic property of a fluid volume (col. 45 lines 46-55) in a small volume device ....” *Office Action of July 5, 2006*, page 2. Without agreeing the assertions of the July 5<sup>th</sup> Office Action, Applicants have amended claims 1 and 32 to better capture the envisioned commercial embodiments. Applicants assert that the amendments to these claims, which flow through to their dependent claims, render moot the anticipation rejection under 35 U.S.C. §102(e).

The present claims are currently directed towards methods for determining a dynamic property of a fluid volume in a small volume device comprising determining the distribution or location or both of at least one resonance light scattering particle in the fluid volume by detecting light scattered from said at least one resonance light scattering particle. Schultz, on the other hand, is limited to the use of resonance particles where the particles themselves are specifically bound to a binding partner. Indeed, the passage upon which the Office Action relies is directed solely towards resonance particles that are specifically conjugated or bound to cells or to molecules within cells. According to Schultz, “[o]nce bound, the PRE [(plasmon resonant entity)] can be localized and its motion observed.” United States Patent No. 6,180,415, col. 45, ll. 42-43. Thus, Schultz does not teach or suggest that the resonance particles may be unbound within a fluid. Because Schultz does teach or suggest each and every element of the presently claimed invention, Applicants assert that Schultz does not anticipate claims 1-5, 7, 8, 18, 19 and

32-35 as amended. Applicants earnestly solicit reconsideration and withdrawal of the outstanding anticipation rejection.

### **III. THE OBVIOUSNESS REJECTIONS ARE MOOT**

#### **A. Schultz and Tateiwa**

The Office Action of July 5, 2006 rejected claim 6 under 35 U.S.C. 103 as allegedly “being unpatentable over Schultz (US 6,180,415) in view of Tateiwa (US 5,444,529).” *Office Action of July 5, 2006*, page 4. Without agreeing the assertions of the July 5<sup>th</sup> Office Action, Applicants have amended claim 1 to better capture the envisioned commercial embodiments. Applicants assert that the amendments to these claims, which flow through to their dependent claims, render moot the obviousness rejection under Schultz in view of Tateiwa.

As discussed above, Schultz does not teach and every limitation of the presently claimed invention, and Applicants assert that Tateiwa does not rectify these deficiencies. Indeed, Schultz does not teach the use of unbound resonance particles to determine a dynamic fluid property. Further, the Office Action establishes that Tateiwa does not disclose or teach the use of resonance particles (*See* page 6). Thus the combination of Schultz and Tateiwa cannot and does not teach or suggest the use of unbound resonance particles to determine fluid dynamic properties.

Because the combination of Schultz and Tateiwa does not disclose each and every element of the claimed invention, the combination of cited references do not establish a *prima facie* case of obviousness against the presently claimed invention. Applicants respectfully request reconsideration and withdrawal of the outstanding obviousness rejection.

#### **B. Schultz**

The Office Action of July 5, 2006 rejected claim 6 under 35 U.S.C. 103 as allegedly “being unpatentable over Schultz (US 6,180,415).” *Office Action of July 5, 2006*, page 5. Without agreeing the assertions of the July 5<sup>th</sup> Office Action, Applicants have amended claim 1 to better capture the envisioned commercial embodiments. Applicants assert that the amendments to these claims, which flow through to their dependent claims, render moot the obviousness rejection under Schultz.

The deficiencies of Schultz have been discussed herein. Further, the Office Action establishes that Schultz does not teach or suggest specific volumes in which the fluid dynamic properties can be determined. Because Schultz does not disclose each and every element of the presently claimed invention, Schultz cannot establish a *prima facie* case of obviousness against the presently claimed invention. Applicants respectfully request reconsideration and withdrawal of the outstanding obviousness rejection.

### **CONCLUSION**

Applicants have amended claims 1 and 32 to better capture the envisioned commercial embodiments. Applicants assert that the claim amendments do not introduce new matter and that the claim amendments render moot the anticipation and obviousness rejections. Applicants request reconsideration and withdrawal of the outstanding anticipation and obviousness rejections.

Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, he or she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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